

I hereby certify that this correspondence is being filed via
EFS-Web with the United States Patent and Trademark Office
on Nov. 21, 2006

PATENT
Attorney Docket No. 021024-000110US

TOWNSEND and TOWNSEND and CREW LLP

By: Kay Garland

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Gregory F. Borton

Application No.: 09/813,636

Filed: March 21, 2001

For: ACTIVITY-BASED BUSINESS
MODELING

Confirmation No. 3366

Examiner: Tan D. Nguyen

Technology Center/Art Unit: 3629

APPELLANT'S REPLY BRIEF

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants offer this Reply Brief in response to the Examiner's Answer mailed September 26, 2006. The following remarks are intended to further focus the issues in this appeal.

Remarks

In response to the arguments in the Examiner's Answer mailed September 26, 2006 ("Examiner's Answer"), Appellants wish to address certain issues raised by the Examiner.

Appellants note with appreciation that the Examiner has withdrawn a number of Grounds of Rejection (II & VI) and Objection (I).

Much of Examiner's Answer is repeated from the Final Office Action dated March 16, 2006, and thus has been sufficiently addressed in the Appeal Brief submitted June 28, 2006. However, certain issues merit further discussion:

Ground of Rejection I:

The Office Action has rejected claims 1-6, 22, 7-12 and 19-21 under 35 U.S.C. §103(a) as being unpatentable over Morgan.

1. Task and Resource Entries: The Examiner asserts in his Answer that task and resource entries should receive no patentable weight.

Throughout the Specification, the term "entry" is used on numerous occasions, and the use in the claims is abundantly clear. For example, the Specification provides: "*tasks, resources, and systems* for many common business areas are available in templates to pre-populate the various data *entry* screens" (emphasis added, Original Application, p. 7, ll. 11-12). And the interaction between tasks, resources, systems, and entry screens is made clear as well (*Id.*, p. 8, ll. 2-4). Appellants note that the claims are not to be viewed in a vacuum, but in light of the Specification (*See, e.g., Phillips v. AWH Corp.*, Fed. Cir., No. 03-1269, 7/12/05). Appellant respectfully asserts that the claim terms at issue are clear, and the arguments to discard them are without merit.

Each of independent claims 1, 7, and 19 recites task entries "comprised of *defined types of future action*." (emphasis added) The Office continues to rely on Morgan to teach these limitation (Examiner's Answer, p. 19, ll. 1-11). But Appeal Brief clearly points out the differences between the teachings of Morgan and the claims at issue (Appeal Brief, pp. 6-8).

Morgan describes a "forecasting [wherein] the automated activity-based management system 10 preferably uses *historical activity information* " (*Morgan*, col. 7, ll. 56-60). The Morgan forecasting is based on *historical* information and projections for equipment utilization, activity cost information, and product volume - not *tasks* (*Morgan*, col. 3, l. 66 - col. 4, l. 3).

The "tasks" described in the present embodiments comprise "defined types of *future action*" (emphasis added). The task entries are generic components (e.g., research, cold calls, and follow up) of action that can be combined to complete different activities (e.g., sales) in the future (Morgan, col. 5, ll. 3-4). The system in Morgan differs in that it looks backward to *specific* employee activities that have *already occurred*, and may make projections based on these past activities (Id., col. 8, ll. 32-51; Fig. 10).

2. Mapping: Moreover, the mapping in claims 1 and 19 is directed at mapping future *tasks* to future *resources*, and claim 7 makes a like correlation between tasks and resources. But Morgan maps past *expenditures* to *activities* (Morgan, col. 4, ll. 21-28). It is evident that the backward facing expenditure/activity mapping of the reference fails to teach the future task/resource mapping of the claims.

The mapping in the claims calls for future defined tasks to be tied to future resources (personnel and non-personnel) that will be needed to accomplish them. This is different than Morgan, which maps past "*expenditures to activities*" to identify how money "*was spent*" (emphasis added, Morgan, col. 4, ll. 21-28).

3. Processing Before Any Historical Information Entry: Independent claim 7 recites "processing the resource entry and the task entry with a computer before entry of any historical information for the organization ... [to formulate] a business model." There is no teaching or suggestion in Morgan which reads on this limitation.

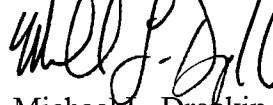
Gregory F. Borton
Appl. No. 09/813,636
Page 4

PATENT
Attorney Docket No. 021024-000110US

CONCLUSION

For these reasons, it is respectfully submitted that the rejection should be reversed.

Respectfully submitted,



Michael L. Drapkin
Reg. No. 55,127

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 650-326-2422
60886772 v1